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MAY 2 7 2004

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Kathy L. Crew

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10/625227 PI1270USCNT

Response to Restriction Requirement 3 Mos, Extension of Time Fee Sheet Deposit Account Authorization Certificate of Transmission

This collection of information is required by 37 CFR 1.8. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application, Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 1.8 inhutes to complete, including pathering, preparing, and submitting the completed application form to the USPTO. Time will very depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing the burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

NO.741 P.2

Attorney Docket No. PI1270 US CNT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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In re U.S. Patent Application of:

MAY 2 7 2004

Helen S.M. Lu, et al.

Group Art Unit:

1621

OFFICIAL

Serial No.: 10/625,227

Examiner:

Michael L. Shippen

Filing Date: July 23, 2003

Confirmation No:

8629

Title: 3-ALKYLATED-5,5',6,6',7,7',8,8'-OCTAHYDRO-2,2'-BINAPHTHOLS AND 3,3'-DIALKYLATED-5,5',6,6',7,7',8,8'-OCTAHYDRO-2,2'-BINAPHTHOLS AND PROCESSES FOR MAKING THEM

MAIL STOP AMENDMENT Commissioner for Patents PO Box 1450 Alexandria, VA 22313-1450

RESPONSE TO RESTRICTION REQUIREMENT UNDER 35 U.S.C. § 121

Sir:

The present communication is responsive to an Office Action dated January 28, 2004 in the above-captioned application (the "Application") requiring a restriction of the claims submitted for examination. A petition for a three (3) months extension of time in which to file this response along with the requisite fee is filed herewith.

Claims 1-19 are currently pending in the Application. In the Office Action, it was asserted that the Application contains claims which are directed to distinct inventions. As a result, the Examiner issued a Restriction Requirement requiring the election of a single group of claims for prosecution.

The claims, as grouped by the Examiner, appear as follows:

- I. Claims 1 and 18, drawn to compounds, classified in class 568, subclass 719.
- II. Claims 2-11, drawn to processes using an alkene reactant, classified in class 568, subclass 719.
- III. Claims 12-14, drawn to processes using a halide reactant, classified in class 568, subclass 719.
- IV. Claims 15 and 16, drawn to processes using sulfonate reactant, classified in class 568, subclass 719.
- V. Claim 17, drawn to a process using an alcohol reactant, classified in class 568,
 subclass 719.

Applicants respectfully traverse the Restriction Requirement.

Initially, Applicants note that the Application was filed with 19 claims, although only 18 claims are listed as pending in the Office Action. Claim 19 is dependent from claim 18 and Applicants therefore respectfully submit that Claim 19 should have been included in the claims designated as Group I.

The Examiner states that the inventions are distinct, each from the other because the claims of Groups I and II, III, IV or V are related as process of making and product made.

According to MPEP § 806.05(f), the inventions are distinct if it can be shown either that (1) the process as claimed can be used to make other and materially different products, or (2) the product can be made by another and materially different process. The Examiner asserts that the processes can be used to make compounds outside of the claims of Group I and that the claims of Groups II-V evidence that the product may be prepared by more than one process. Office Action at pg. 2.

Under the patent statute, 35 U.S.C. § 121, an application may be properly required to be restricted to one of two or more claimed inventions, only if they are able to support separate patents and they are either independent or distinct. 37 C.F.R. § 1.141; MPEP § 803. However, if the search and examination of an entire application can be made without serious burden, then the examiner must examine it on the merits, even if it includes claims to distinct or independent inventions. MPEP § 803. Here, all five groups of claims are all classified in the same class and subclass: class 568, subclass 719. Thus, Applicants respectfully submit that a search of patent documents would not constitute a serious burden on the Examiner.

The Examiner asserts that despite identical classification, the search would require a divergent search of the literature. Office Action at pg. 3. However, Applicants note that in addition to the same classification, all groups of claims contain a common reactant (5,5',6,6',7,7',8,8'-octahydro-2,2'-binaphthol). Furthermore, the claims of Groups II-V include the limitation of an acid catalyst. Thus, Applicants submit that even a literature search would not be as burdensome as suggested by the Examiner.

Applicants respectfully submit that a five-way restriction is a severe measure, particularly in light of the limited number of claims (19) and the overlapping nature of the subject matter as demonstrated by the identical classifications of all five groups of claims. In light of the foregoing, Applicants respectfully request the Examiner reconsider the Restriction Requirement.

Notwithstanding the above, in order to comply with the Restriction Requirement,

Applicants elect with traverse the claims of Group I. Applicants further request that the
remaining claims be held in abeyance under the provisions of 37 C.F.R. § 1.142(b) until final
disposition of the elected claims. In electing Group I, Applicants again note that claim 19 was
omitted from the claims as grouped by the Examiner in the Office Action. However, Applicants

U.S. Patent Application No. 10/625,227

respectfully submit that because claim 19 is dependent from claim 18, claim 19 should also be examined with the claims of Group I.

The Examiner has further indicated that if the claims of Group I are elected, that

Applicants "must provisionally elect a single disclosed and claimed species, i.e. a single
compound." Office Action at pg. 3. It is asserted by the Examiner that the members of the

Markush groups of claims 1 and 18 are so unrelated and diverse that a prior art reference
anticipating the claims with respect to some members would not render the claims obvious under

35 U.S.C. § 103 with respect to all of the other members. Id.

As Applicants have elected Group I, Applicants provisionally elect the compound of claim 1 designated by formula 2, wherein R is an isopropyl group. The elected compound reads on all of the claims of Group I and has the structural formula as shown:

U.S. Patent Application No. 10/625,227

If the Examiner has any questions regarding the election of the claims of Group I or the elected species, the Examiner is invited to contact Applicants' undersigned representative for a telephone conference to resolve such questions in an expeditious manner.

Respectfully submitted,

Charles E. trubel

INVISTA, North America S.à.r.l 4417 Lancaster Pike Intellectual Property - Bldg. 722/WR1032 Wilmington, Delaware 19805

Tel.: (302) 999-3708 Fax: (302) 999-3881 Charles E. Krukiel Attorney for Applicants Registration No. 27,344

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In the Application of:

HELEN S.M. LU, ET AL.

CASE NO.:

PI1270USCNT

APPLICATION NO.: 10/625,227

GROUP ART UNIT: 1621

FILED: JULY 23, 2003

EXAMINER: MICHAEL L. SHIPPEN

FOR: 3-ALKYLATED, 5,5'6,6'7,7',8,8'-OCTAHYDRO-2,2'-BINAPHTHOLS AND

3,3'-DIALKYLATED-5,5',6,6',7,7',8,8'-OCTAHYDRO-2,2'-BINAPHTHOLS

AND PROCESSES FOR MAKING THEM

DEPOSIT ACCOUNT AUTHORIZATION

Assistant Commissioner for Patents Washington, D.C. 20231

Sir:

Should any fee be required in connection with the filing of the attached Response to Restriction Requirement Under 35 U.S.C. 121 and the Petition for Extension of Time Under 37 CFR 1.136(a), please charge such fee to Deposit Account No. 03-1165 (INVISTA North America S.à.r.l formerly KoSa).

Respectfully submitted,

Deanna M. McGregor

Authorized User

Telephone: (302) 999-3944 Facsimile: (302) 999-3881

Dated:

Under the Paperwork Reduction Act of 1995, no persons are required to respond

FEE TRANSMITTAL

for FY 2004

Effective 10/01/2003. Petent fees are subject to annual revision.

Applicant claims small entity status. See 37 CFR 1.27

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Signature

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Application Number Filing Date

First Nemed Inventor

Attomey Docket No.

Examiner Name

950.00

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This collection of Information is required by 37 CFR 1.17 and 1.27. The Information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the Individual case. Any comments on the amount of time you require to complete this form end/or suggestions for reducing this burden, should be sent to the Chief Information Officer. U.S. Pepartment of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450, DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS, SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Date

May 27, 2004